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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,754	01/16/2002	Stephen J.H. Owens	CRA1364-505G	2722

8698 7590 05/21/2003
STANDLEY & GILCREST LLP
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EXAMINER

WOO, STELLA L.

ART UNIT	PAPER NUMBER
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2643

DATE MAILED: 05/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/050,754

Applicant(s)
Owens et al.

Examiner
Stella Woo

Art Unit
2643



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- ## Disposition of Claims
- 4) ☒ Claim(s) 1-157 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-157 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-81, 83-88, 90-106, 108-157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohn et al. (US 5,740,231, hereinafter "Cohn") in view of Larson et al. (USPN 5,825,854, hereinafter "Larson"), and further in view of Gordon (USPN 5,608,786).

Cohn discloses an electronic communications system comprising:

means for sending messages in accordance with a first communication medium (voice, electronic mail, facsimile, or video; col. 8, lines 45-53);

means for defining a plurality of rules to apply to said messages (a universal database is maintained which stores individual communication profiles; col. 7, line 59 - col. 8, line 21);

means for applying (media translator 69 converts messages from one media to another in accordance with the user profile record; col. 13, lines 35-40; col. 22, lines 54 - col. 23, line 26);
and

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means for retrieving (recipient can retrieve the converted message from the mail facility; col. 7, line 66 - col. 8, line 2).

Cohn differs from the claims in that it does not specify the user responding to a message using a third communication medium. However, Larson teaches the desirability of allowing a telephone keypad user to immediately reply to a message using the DTMF keypad (col. 1, lines 55-66; col. 4, lines 14-51) such that it would have been obvious to an artisan of ordinary skill to incorporate the immediate reply function of Larson within the multimedia communications system of Cohn in order to allow users to reply to messages which can be received and sent via any of a plurality of communication media (voice, e-mail, fax or video; Cohn, col. 8, lines 45-53).

Cohn further differs from the claims in that it does not specify the system as comprising an access service. However, Gordon teaches the well known use of a commercial access provider (UniPost Access Nodes; Figure 1; col. 4, line 22 - col. 11, line 14) for providing a customized global messaging system in which a user can receive or retrieve messages which have been converted into the format desired by the user such that it would have been obvious to an artisan of ordinary skill to incorporate such well known use of access service providers within the messaging system of Gordon in order to provide distributed, global access to the message service subscribers.

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Regarding claims 4-5, 12-13, Cohn provides for filter-and-forward options based on urgency, subject matter or source (col. 25, lines 35-46; col. 27, line 29 - col. 28, line 34; col. 29, line 35 - col. 30, line 32).

Regarding claims 6 and 14, Cohn provides for store-and-forward operation (col. 28, lines 35-47).

Regarding claims 7 and 15, the sender can label a message as "urgent" (col. 27, lines 59-63) and the recipient can set media preferences (col. 22, lines 54-59).

Regarding claim 8, the rules are stored at and applied by communication system 10 (col. 7, line 62 - col. 8, line 7).

Regarding claims 16-31, Cohn discloses a cross-media communication system (multimedia network-based communications system 10) comprising:

- a computer network (communications network 18; col. 7, lines 5-43);

- a telephone access interface (a network hub includes an analog connection processor 52 for sending and receiving voice, fax, and modem communications; col. 13, lines 42-64);

- an electronic mail gateway (gateway 33 connects with other messaging systems, including electronic mails systems; col. 7, lines 34-43 and digital connection processor 54 collects and distributes e-mail; col. 15, lines 21-41); and

- means for accessing electronic mail messages (recipient can access the e-mail messages via telephone; col. 13, lines 35-38; col. 24, lines 1-3, 12-29).

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Method claims 32-81, 83-88, 90-106, 108-157 recite steps which are carried out by the combination of Cohn, Larson and Gordon as described above.

Regarding claims 111-114, in Cohn, subscribers can access the system via user computer terminals 171 through a customer computer interface system 167 (col. 23, line 66 - col. 24, line 18) and messages can be delivered as compound messages (e.g. e-mail with voice or fax data; col. 26, line 55 - col. 28, line 26).

Regarding claim 39, Cohn provides for connection with an Internet Service Provider mail service (col. 10, lines 14-22; col. 11, lines 11-17; col. 15, lines 24-32; col. 16, lines 17-34).

Regarding claims 40-42, 51-52, 78-81, 83, 93-94, 101-103, 142-157, subscribers can be notified by pager or other telephone number of received mail messages (col. 28, lines 1-8).

3. Claims 82, 89, 107 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Cohn, Larson and Gordon, and further in view of Levac et al. (USPN 5,872,926, hereinafter "Levac").

The combination differs from claims 82, 89, 107 in that although it provide for receiving a mail notification message at a pager (Cohn, col. 28, lines 1-8), it does not specify receiving the actual text of the e-mail message at the pager. However, Levac teaches the desirability of allowing an e-mail recipient to receive the mail text at an alphanumeric pager (col. 5, lines 6-25) such that it would have been obvious to an artisan of ordinary skill to expand the combination by allowing for receipt of e-mail messages at alphanumeric pagers as well, as taught by Levac.

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Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mulligan et al.(US 5,937,161), Irribarren (US 5,737,395), and Rhee (US 5,524,137) show other multi-media messaging systems.

5. **Any response to this action should be mailed to:**

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Washington, D.C. 20231

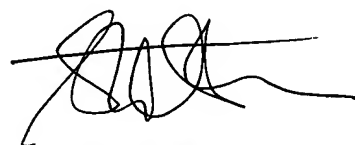
or faxed to:

(703) 872-9314.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395. Any general inquiries should be directed to the Customer Service Office at (703) 306-0377.

May 19, 2003



STELLA WOO
PRIMARY EXAMINER